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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,802	03/30/2004	Tsuyoshi Takemoto	12-047	2836

23400 7590 05/02/2007
POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON, VA 20191

EXAMINER

WEINSTEIN, LEONARD J

ART UNIT	PAPER NUMBER
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3746

MAIL DATE	DELIVERY MODE
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05/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/811,802

Applicant(s)

TAKEMOTO, TSUYOSHI

Examiner

Leonard J. Weinstein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/30/2004</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application</p> <p>6) <input type="checkbox"/> Other: _____</p> |
|---|--|

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - a. Lines 31-35 on page 6 – element 134 is recited as being contained by element 132.
 - b. Lines 31-35 on page 6 and lines 11-15 on page 7 - element 135 is recited as being contained by element 133.

As best understood by the examiner and as shown in figures 2A and 4, elements 134 and 135 are connected to elements 132 and 133 respectively and not contained within the elements as discussed. Appropriate correction is required.

Claim Objections

2. Claim 4 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 3. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). The recitation of an "engagement protrusion and said engagement hole are both shaped, substantially, as a column" recites the same limitation of claim 3 whereby the same elements of the invention are shaped as a "pillar." The description of an element as a pillar does not distinguish from an element shaped like a column since a pillar and a column are synonymous.
3. Claim 5 is objected to for reciting the limitation of an "output terminal" and "conductor pattern" being "both formed of resin by insert molding." The limitation is considered to be a product-by-process and the determination of patentability in a product-by-process claim is

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based on the product itself, even though the claim may be limited and defined by the process. That is, the product in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). A product-by-process limitation adds no patentable distinction to the claim, and is unpatentable if the claimed product is the same as a product of the prior art. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-4 and 7-8 are rejected under 35 U.S.C. 102(a) as being anticipated by Makino et al. US 2003/0002998. Makino teaches all the limitations as substantially claimed for a motor driven compressor including: an electrical motor 13 for driving a compressor mechanism 10 which sucks and compresses refrigerant, a motor housing 12 in which said motor 13 is accommodated and fluid flows (fig. 1), a driving circuit board 114 which is mounted on the outside of said motor housing 12 and on which a motor driving circuit 106, for driving said motor 13 is formed, an output terminal 105 which is mounted on said driving circuit board 114 and outputs driving power for said motor 13, and an input terminal 15 which penetrates said motor housing 12, for inputting said driving power to said motor 13 while sealing said motor housing 12 against leakage of said fluid (¶0027), wherein said output terminal 105 and said input terminal 15 are directly engaged and electrically connected with each other (fig. 1); an input terminal 15 has an engagement protrusion 15c protruded to the outside of said motor

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housing 12, said output terminal 105 has an engagement hole, 15a of element 105 (§0035), corresponding to the shape of said engagement protrusion 15c, and said engagement protrusion 15c and said engagement hole, 15a of element 105 (§0035), are engaged with each other so that said output terminal 105 and said input terminal 15 are electrically connected with each other (§0035); an engagement protrusion 15c and an engagement hole, 15a of element 105 (§0035), are both shaped, substantially, as a pillar (fig. 1); an engagement protrusion 15c and an engagement hole, 15a of element 105 (§0035), are both shaped substantially as a column (fig. 1); a driving circuit board 114 is of a laminated construction, elements 114 and 131, and an engagement hole, element defined around element 124, is provided in the lower-layer board, element 114 of elements 114 and 131; and a fluid that is sucked by a compressor mechanism 10 being sucked refrigerant (§0027).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makino et al. 2003/002998 in view of Gennami et al. US 2002/0136653. Makino teaches all the limitations as discussed including a driving circuit board 114 having a conductor pattern 131 connected with an output terminal 105, via element 15, and a resin casing 126 for driving circuit board 114, in which a space 101 for accommodating said driving circuit board 114 is provided. Makino fails to teach the following limitations that are taught by Gennami for a compressor including: an output terminal 66 and a conductor pattern 67 both formed of resin; and a driving circuit board 62 and a casing 70 for driving circuit board 62 are molded in one piece, as shown in figure 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify a motor driving circuit for a compressor with and inverter control to include a conducting pattern and an output terminal made of resin and a driving circuit formed as one piece with a casing for a circuit in order to reduce the space needed for a motor to inverter connection and reduce the size of a compressor (Gennami ¶0032).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are cited in form 892 herewith.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard J. Weinstein whose telephone number is 571-272-9961. The examiner can normally be reached on Monday - Thursday 7:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LJW



ANTHONY D. STASHICK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700